

REMARKS

The present reply is submitted in response to the Office Action dated January 13, 2005. In the Office Action, claims 1-15 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In addition, claim 8 was objected to because of informalities. Moreover, claims 1-9 and 17-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Apgar IV (U.S. Patent No. 5,680,305). In addition, claims 10-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Apgar IV. Applicants note that no disposition is presented for claim 16, and respectfully request clarification regarding the same.

With respect to the rejection of independent claim 1 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, Applicants respectfully submit that claim 1 has been amended to define that the evaluation method and system are implemented by a computer. Applicants respectfully submit that the present amendment overcomes the rejection thereto.

With respect to the objection of claim 8, Applicants have amended claim 8 to spell out the abbreviations “EBIT,” “EBITDA” and “P&L.” Applicants have further amended claim 8 to spell out the abbreviation “EPS.” Applicants respectfully submit that the amendments overcome the objections thereto.

With respect to the rejection of independent claims 1 and 17, Applicants respectfully submit that the claims, as written, distinctly define the claimed subject matter in view of the cited reference. More specifically, Applicants respectfully submit that the present invention relates to evaluating financing structures in relation to a real estate asset for the procurement of the real estate asset by an entity, such as by ownership, leasehold or

other control structures. For example, financing structures may include, but are not limited to, purchase of the real estate such as with corporate funds, debt, via a real estate investment trust, or via a partnership or joint venture with another individual or entity. Likewise, an individual may lease real estate such as via a short-term lease, a long-term lease, a credit sale and lease back, a tax-motivated leveraged lease or a synthetic lease, for example. *See Specification, pp. 1, 2.*

Apgar IV, however, fails to teach or even remotely disclose a method or system for evaluating real estate financing structures to determine the best or optimal way to procure the real estate, but instead relates to a system and a method of evaluating the condition of the real estate. For example, Apgar IV is best summarized by its Abstract:

Systems and methods of the invention provide objective evaluations of a business entity's real estate situation and condition for use by customers including (but not limited to) the business entity.

Moreover, Apgar IV teaches compiling a score, including indicators such as Amount, Price, Grade, Area and Risk, which directly relate to the condition of the real estate. In essence, Apgar IV appears to teach and disclose systems and methods for evaluating whether to procure real estate, not how best to procure the real estate, as in the present invention.

Under 35 U.S.C. § 102, anticipation requires that a single prior art reference disclose each and every element of the Applicants' claimed invention. *See Akzo N.V. v. International Trade Commission*, 808 F.2d 1471, 1479 (Fed. Cir. 1986). Therefore, Applicants respectfully submit that independent claim 1 is allowable over the Apgar IV reference.

Claims 2-16 depend from independent claim 1; and claims 18-20 depend from independent claim 17. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims since each sets forth additional steps and components of Applicants novel method and system, respectively.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone the Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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